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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/825,491

04/15/2004

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10/20/2009

EXAMINER

RACHUBA, MAURINA T

ART UNIT

PAPER NUMBER

3727

MAIL DATE

DELIVERY MODE

10/20/2009

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 10/825,491	Applicant(s) HATANO ET AL.	
	Examiner Maurina Rachuba	Art Unit 3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 12 August 2009.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 9-11 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 9-11 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 15 April 2004 is/are: a) ☒ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. _____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Continued Examination Under 37 CFR 1.114

1. A request for continued examination under 37 CFR 1.114, including the fee set forth in 37 CFR 1.17(e), was filed in this application after final rejection. Since this application is eligible for continued examination under 37 CFR 1.114, and the fee set forth in 37 CFR 1.17(e) has been timely paid, the finality of the previous Office action has been withdrawn pursuant to 37 CFR 1.114. Applicant's submission filed on 15 July 2009 has been entered.

Claim Rejections - 35 USC § 112

2. Applicant has overcome the rejections under 35 USC 112.

Claim Rejections - 35 USC § 102

3. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

4. Claims 9 is rejected under 35 U.S.C. 102(b) as being anticipated by, or, in the alternative, under 35 USC 103(a) as obvious over JP 2002-126985, cited by applicant, English language equivalent Hatano et al, 6,688,944, as set forth in the Office action mailed 16 April 2009. Further, applicant has amended the claims to limit “a display configured to display a special chamfering positional mark showing a position of the lens shape, a chamfering positional mark showing a most thinning position of an edge

thickness and a chamfering width, a sectional shape at the chamfering positional mark of the lens shape and an edge sectional shape at the special chamfering positional mark of the lens shape to carry out a simulation processing of the eyeglass lens", and "wherein a state of a chamfering portion is changed in the simulation when the special chamfering positional mark is moved toward the chamfering positional mark". It is the examiner's position that '985 clearly discloses this feature. Please refer to '944, column 12, lines 54 through column 13, lines 7. '985 discloses that the display is configured to display a special chamfering positional mark **Mcf** showing a position of the lens shape, a chamfering positional mark **Mtn** showing a most thinning position of an edge thickness and a chamfering width, a sectional shape at the chamfering positional mark of the lens shape and an edge sectional shape at the special chamfering positional mark of the lens shape to carry out a simulation processing of the eyeglass lens (figure 9). Further, '985 teaches that a state of a chamfering portion is changed in the simulation when **Mcf** is moved toward **Mtn**, because the thickness of the lens, and the chamfering widths, change as the arbitrarily positioned special chamfering positional mark is changed relative to the chamfering positional mark, so therefore a "state of a chamfering portion" would change as well, again, please refer to '944, column 11, lines 54 through column 13, lines 51. While '985 does not use the term "simulation", by entering the data, and using the data to predetermine the chamfering of the lens, '985 performs a chamfering simulation. Note that '985 (and '944) discloses the method comprising the steps of: preparing an eyeglass lens having an anterior refracting surface and a posterior refracting surface; forming a V-shaped portion on the edge

surface; forming a front edge portion on the edge surface at one side of the V-shaped portion disposed adjacent to the anterior refracting surface, and forming a back edge portion on the edge surface at a second side of the V-shaped portion disposed adjacent to the posterior refracting surface; and chamfering the posterior refracting surface so that a width of the back edge portion in a thickness direction of the eyeglass lens is larger than a width of the front edge portion. As shown in figure 10, and prior art figure 11, the width of the back edge portion is greater than the width of the front edge portion.

Claim Rejections - 35 USC § 103

5. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

6. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

7. Claims 10 and 11 are rejected under 35 U.S.C. 103(a) as being obvious over JP 2002-126985, cited by applicant, English language equivalent Hatano et al, 6,688,944.

Regarding claims 10 and 11, limiting the specific relative sizes of the portions, '985 discloses that the back edge portion is a greater width than the front edge portion, but does not disclose the relative sizes. One of ordinary skill in the art would have considered it obvious to have provided '985 with portions of whatever size desired, including that shown in figure 10. A change in size is generally recognized as being within the level of ordinary skill in the art. In re Rose, 105 USPQ 237 (CCPA 1955).

Response to Arguments

8. Applicant's arguments filed 10 February 2009 have been fully considered but they are not persuasive. Applicant argues that 985 does not disclose the claimed invention. The examiner disagrees, please refer to the above rejection. Applicant has not provided evidence as to how the marks taught by '985 differ from those claimed by applicant.

Conclusion

9. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Maurina Rachuba whose telephone number is 571 272 4493. The examiner can normally be reached on Monday-Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Monica Carter can be reached on 571 272 4475. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

/M. Rachuba/
Primary Examiner, Art Unit 3727